

### Remarks

Claims 1, 3-12, 15-16, and 21-24 have been canceled without prejudice or disclaimer. Applicants reserve the right to pursue the canceled subject matter in one or more continuing applications. Claims 25-58 have been added to claim additional embodiments of the provisionally elected group. In addition, the title has been amended to reflect the provisionally elected sequence, and the format of the cross reference to related applications section has been updated based on the guidance given in 1268 OG 89 (March 18, 2003). Support for the amendments to the specification and claims can be found throughout the specification as filed, and thus, no new matter has been introduced.

More particularly, support for new claims 25-26 and 30-31 can be found, for example, at page 165, lines 18-27, page 290, lines 5-19, and Table 1, page 267, row 9 as indicated as "Gene No. 83" of the specification as filed. Support for new claims 35-38 and 42-45 can be found, for example, at page 275, line 30 to page 283, line 14; page 285, line 14 to page 286, line 19; and page 295, line 4 to page 297, line 4 of the specification as filed. Support for new claims 49-50 and 54-55 can be found, for example, at page 283, line 16 to page 285, line 12 of the specification as filed. Support for new claims 27, 32, 39, 46, 51 and 56 can be found, for example, at page 286, line 21 to page 288, line 14, and Example 9 of the specification as filed. Support for new claims 28, 33, 40, 47, 52 and 57 can be found, for example, at Example 23 of the specification as filed. Support for new claims 29, 34, 41, 48, 53 and 58 can be found, for example, at page 288, line 16 to page 291, line 3 of the specification as filed.

Claims 2, 13-14, 17-20, and 25-58 are pending.

Applicants note that the presently claimed invention Gene No. 83, polynucleotides encoding SEQ ID NO:466, encodes a protein known in the literature as "CD2 binding protein 2" (CD2BP2). Applicants also note that it is asserted in the specification that the presently claimed invention is expressed in lymphoma and fetal lung cells, and can thus be useful for the diagnosis of diseases and conditions which include, but are not limited to, respiratory and hematopoietic disorders. *See* page 166, lines 8-27 of the specification.

Applicants respectfully assert that the claimed invention fully complies with the requirements of 35 U.S.C. §§ 101 and 102. In particular, Applicants have asserted that the claimed polynucleotides are useful, for example, in the diagnosis (*i.e.*, as a diagnostic marker) of respiratory and hematopoietic disorders. *See supra*. These assertions of utility are specific, substantial and credible.

Applicants point out that the credibility of the asserted utilities is further supported by data published after the effective filing date of the captioned application. Binding of CD2BP2 to CD2 enhances the production of interleukin 2 (IL-2) in CD2-expressing cells. *See* Figure 5 of Nishizawa *et al.* (1998) Proc Natl Acad Sci USA 95:14897-14902 (submitted herewith in the Information Disclosure Statement as reference A). It is well known in the art that IL-2 activation is critical in both asthma and the immune response. Thus, the claimed polypeptide is, more likely than not, implicated in the pathogenesis of respiratory and hematopoietic disorders and would therefore be useful to diagnose such disorders as asserted in the specification.

### **Provisional Election With Traverse**

Pursuant to Paper No. 5, mailed June 17, 2003, the Examiner has required an election under 35 U.S.C. § 121 of one of Groups I-VIII. The Examiner contends that the inventions are distinct, each from the other.

In response, Applicants provisionally elect, *with traverse*, the invention of Group III, represented by original claims 11-12, 16, and 23 (now canceled), and new claims 25-54, drawn to, *inter alia*, polypeptides, for further prosecution. Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the restriction requirement be made final. Applicants point out that claims 1, 3-12, 15-16, and 21-24 have been canceled without prejudice or disclaimer, and that new claims 25-54 are directed to subject matter falling within the ambit of Group III as cast by the Examiner.

With respect to the Examiner's division of the invention into eight groups and the reasons stated therefor, Applicants respectfully disagree and traverse.

Applicants point out that even where patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the search and examination of these groups would entail a "serious burden." *See* M.P.E.P. § 803. In the present situation, although the Examiner has argued that Groups I-VIII are separately classified or constitute divergent subject matter, Applicants nonetheless submit that a search of the claims of any of the groups would also provide useful information for the claims of the other groups. For example, in many if not most publications disclosing a protein, the authors also disclose nucleic acids encoding the protein, antibodies to the protein, and methods of making and using the same. Thus, since the searches for proteins, nucleic acids encoding such proteins, antibodies to such proteins, and methods of making

and using the same commonly overlap, the combined search and examination of such compositions and methods using the same would not entail a serious burden, even assuming *arguendo* that all of the searches were not coextensive. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement and examine the subject matter of Groups I-VIII together in the present application.

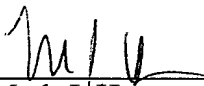
Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

### **Conclusion**

Applicants respectfully request that the above-made amendments and remarks be entered and made of record in the file history of the instant application. If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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